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Dated: August 26, 2008

Signature: Donna Dobson
(Donna Dobson)

Docket No.: 61135/P016US/10106022
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Martin J. Pagel

Application No.: 09/469,561 | Confirmation No.: 5104

Filed: December 22, 1999 | Art Unit: 3628

For: POSTAL PRINTER DRIVER SYSTEM AND METHOD | Examiner: R. Wu

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated June 26, 2008, and is in furtherance of the Appeal Brief filed on May 12, 2008.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

I. Status of Claims
II Ground of Rejection to be Reviewed on Appeal
III. Argument
IV Conclusion

I. STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief submitted May 12, 2008 which is as follows:

A. Total Number of Claims in Application

There are 44 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 5, 15, 20, 28, 29, 35 and 36;

2. Claims withdrawn from consideration but not canceled: none;

3. Claims pending: 1-4, 6-14, 16-19, 21-27, 30-34, and 37-51;

4. Claims allowed: none; and

5. Claims rejected: 1-4, 6-14, 16-19, 21-27 30-34, and 37-51.

C. Claims On Appeal

The claims on appeal are claims 1-4, 6-14, 16-19, 21-27, 30-34, and 37-51.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed remain as identified in the Appeal Brief submitted May 12, 2008, which are as follows:

Claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34, and 37 – 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,684,706 to Harman et al. (hereinafter "Harman").

III. ARGUMENT

The Examiner's Answer confirms Appellant's assertion throughout the prosecution of the current application that Appellee's obviousness rejection of the claims is based on improper hindsight reconstruction. "A factfinder should be aware . . . of the distortion caused by hindsight bias . . . ."). *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) (2007) (citing *Graham*). To avoid repeating the arguments made in the Appeal Brief for the sake of brevity, Appellant incorporates those arguments by reference and addresses the new arguments raised in the Examiner's Answer.

A. Claim 1

Claim 1 recites, "abstracting . . . data bits from said data stream . . . wherein said data stream is provided by an application which has not been adapted to control said additional functions . . . ." Appellant has asserted that, in Harman, Microsoft Word, the application relied upon by Appellee to meet the claim limitations, does not provide a data stream to the parser 112—the device Appellee asserts as abstracting data bits. Appellant has pointed to Harman disclosing two instances where the data stream from Microsoft Word is modified before it is presented to parser 112. Appellee contends that Harman's disclosure of adding postage values to the data stream from Microsoft Word is optional. Examiner's Answer, page 23. However, all the embodiments disclosed in Harman, requires that the data stream from the Microsoft Word application is modified before presentation to parser 112.

Specifically, in the embodiment Appellee now relies on, the postal values are not provided at mail center controller 4. When the postal values are not provided by mail center controller 4, they are provided from the data store 38 by driver 37. As Harman Fig. 3 shows, driver 37 modifies the data stream from the word processing application, e.g. Microsoft Word, with the data from data store 38. Therefore, whether the preferred embodiment in Harman applies or not Harman modifies the data stream from Microsoft Word prior to presentation to parser 112. Thus, Harman does not meet the claim language requiring "abstracting . . . data bits from said data stream . . . wherein said data stream is provided by an application . . . ."

In seeking to overcome the explicit disclosure in Harman that driver 37 modifies the data stream from Microsoft Word, Appellee asserts a combination of Microsoft Word and driver 37. This combination, however, contradicts the claim language, which requires the data stream, provided by an application, not being adapted to control additional functions. Appellant asserts there is no contradiction and Harman would simply function to create the job data and would not be adapted to control any additional functions. Examiner's Answer, page 24. This is improper hindsight reconstruction. To support the combination of the word processing application and driver 37, Appellee quotes Harman:

> "It is well within the skill of a person of ordinary skill in the programming arts to modify a word processing application or produce a special application which **would enable a system to**

> **provide such varying attribute data for mail piece headers 18** . . . ." (emphasis added).

Appellee has not taken into account that varying the attribute data in Harman controls additional functions such as printing a postage indicia:

> Mail piece header 18 includes the same (or a subset of the) mail piece data elements included in job header 12 to define the mail piece attributes specific to the corresponding mail piece. Col. 4, lines 14 – 17.
>
> when the mail piece is to be franked and the postage value has not been determined a priori, mail center controller 4 calculates postage and material costs in accordance with the mail piece data and appends a postage value to mail piece header 18. Col. 5 line 66 – col. 6, line 3.

In other words, to create motivation to combine Microsoft Word and driver 37, Appellee reads Harman to support modifying mail piece header 18 but the fact that modifying mail piece header 18 is modifying the data stream to control additional functions is ignored. Here, Appellee has "use[d] hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784. At least, because Appellee has used improper hindsight reconstruction to reject claim 1, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 1.

B. Claim 17

Claim 17 recites "wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data." Appellee asserts that Harman's teaching of a preestablished data pattern in the job stream teaches this limitation of claim 17. Appellant maintains that asserting that the job data stream has a preestablished data pattern, even if true, in and of itself does not show that Harman teaches abstracting includes examining the data stream for the preestablished data pattern including the beginning and ending of postage indicia. The asserted abstracting, in Harman, may be determined by some other means apart from examining preestablished data patterns. The point is, one skilled in the art would not know how Harman provides the asserted abstracting because Harman is silent on this matter.

Appellant submits that Appellee should not be allowed to reconstruct the art merely for the purpose of supporting an obviousness rejection. Accordingly, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 17.

C. Claim 23

Claim 23 recites, "sending a data stream to a printing device; reviewing said data stream to create therefrom a separate data stream . . . wherein said separate data stream includes data accepted from a source other than said data stream to said printing device . . . calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed . . . ." In the Examiner's Answer, Appellee asserts that the separate data stream is created when data is accepted to determine the weight of the mail piece and determine the appropriate postage value for the mail piece. Examiner's Answer, page 25. This is not sufficient to meet the claim language "reviewing said data stream to create therefrom . . . ."

There is no reviewing of the data stream in the portion of Harman on which Appellee relies. Examiner asserts that the separate data stream is created when data from postal rate data base 119 is added to the data stream. Examiner's Answer, page 25. However, there is no disclosure that there is a reviewing of the data stream before the asserted creation of a separate data stream takes place. Thus, there is no reviewing of the data stream, in the cited portion of Harman, as the claim requires.

Moreover, the separate data stream is not created "therefrom". At best, the portion of Harman on which Appellee relies shows data being added to the data stream. Thus, the data stream Appellee asserts is used to calculate an amount of postage is not a separate data stream therefrom as required by the claims. Instead, it is a modified job data because data has been added to the original job data. Accordingly, Appellant respectfully requests that the Board reverse the rejection under, 35 U.S.C. § 103, of claim 23.

D. Claim 33

Claim 33 recites, "an abstracting program operable for reviewing said data stream . . . wherein said data stream is provided by an application which has not been adapted to control

said additional printing operations . . . ." Appellee asserts parser 112 teaches this limitation of claim 33. Examiner's Answer, page 26. As discussed with regard to claim 1, the job data parser 112 parses is not the data stream sent by Microsoft Word, the application relied upon to meet the claim limitation. "The document data [from the Microsoft Word application] is input to driver 37 and **driver 37 creates the job data by extracting an address from the document data** and accessing data store 38 to define the mail piece attributes . . . ." Col. 4 lines, 43 – 47. Mail center controller 4 then receives this job data and further modifies it by adding data from other sources. Col. 4, lines 35 – 36; Fig. 3 (showing mail center controller combining three data streams to create one data stream). In sum, the data stream the abstracting program reviews in claim 33 is different from the data stream parsed by parser 112 in Harman. Thus, Harman does not meet the claim language requiring "an abstracting program operable for reviewing said data stream . . . wherein said data stream is provided by an application . . . ."

Moreover, Appellee's assertion that Microsoft Word and driver 37 can be combined so as to avoid the explicit provision in Harman that driver 37 modifies the data stream from Microsoft Word contradicts the requirements of claim 33. Claim 33 requires "an application which has not been adapted to control said additional printing operations . . . ." As discussed with regards to claim 1, combining Microsoft Word and driver 37 as Appellee suggests is adapting an application to control additional printing function. Accordingly, Appellant respectfully requests that the Board reverse the rejection, under 35 U.S.C. § 103, of claim 33.

E. Claim 41

Claim 41 requires, "wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data." Appellee asserts that Harman teaches a data pattern in the job data and cites to Fig. 2 as supporting this assertion. Examiner Answer, page 27. Appellee also asserts that parser 112 outputs document data from field 20 and envelope data from field 22 and quotes Col. 7, lines 49 – 52 for supporting this assertion. *Id.*

Appellee does not cite to any portion of Harman, however, to support the assertion that parser 112's outputting document data and envelope data is as a result of examining the

data pattern Appellee points to in Fig. 2. In other words, Appellee's assertion is a mere conclusion based on speculation. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). As such, Appellee has not shown Harman teaches the limitation of claim 41 requiring "wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data."

Claim 41 requires, "an abstracting program operable for reviewing said data stream to obtain therefrom a separate data stream for controlling additional printing operations ancillary to said printing operation . . . said separate data stream for enabling at least one said ancillary printing operation . . . ." Appellee asserts that the separate data stream is created when data is accepted to determine the weight of the mail piece and the appropriate storage into the data stream sent to the printing device. Examiner's Answer, page 28. Similar to the discussion regarding claim 23, this is not sufficient to meet the claim language "reviewing said data stream to obtain therefrom a separate data stream . . . ."

There is no reviewing of the data stream in the portion of Harman on which Appellee relies. Examiner asserts that the separate data stream is created when data from postal rate data base 119 is added to the data stream. Examiner's Answer, page 25. However, there is no disclosure that there is a reviewing of the data stream before the asserted creation of a separate data stream takes place. At best, Harman discloses a review of the postal rate data 119 and the addition of data from data base 119 to the data stream. Thus, there is no reviewing of the data stream, in the cited portion of Harman, as the claim requires.

Moreover, the asserted separate data stream is not obtained "therefrom." At best, the portion of Harman on which Appellee relies shows data being added to the data stream. Thus, the data stream Appellee asserts is used to enable one ancillary operation is not a separate data stream as required by the claims. Instead, it is job data from Microsoft Word modified by other added data. Accordingly, Appellant respectfully requests that the Board reverse the rejection under, 35 U.S.C. § 103, of claim 41.

F. The Dependent Claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, and 47

Claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, and 47 depend from claim 1; claims 24 – 27, and 30 – 32 depend from claim 23; and claims 34, 37 – 40, and 42 – 46 depend from claim 33. As discussed above, claims 1, 23 and 33 are patentable over the applied art. The dependent claims inherit all the limitations from their respective independent claims. For at least this reason, claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are patentable over the applied art. Moreover, the dependent claims themselves recite new and unobvious limitations that are not taught in the applied art.

1. Claim 6

Claim 6 recites, "wherein said at least one additional function further comprises directing the abstracted portion to multiple locations." The Board should note that claim 6 requires " directing the abstracted portion to multiple locations." (emphasis added). In asserting Harman teaches this limitation of claim 6, Appellee relies on the parser outputting document data to page description language interpreter and envelope data to envelope data buffer. Final Office Action, page 16. Appellee has not made clear which of document data or envelope data is "the abstracted portion." Assuming that Appellee considers the document data the abstracted portion, Harman teaches it is sent only to page description language interpreter 114. Alternatively, if envelope data is the abstracted portion, Harman provides the envelope data is sent only to envelope data buffer 118. Appellant asserts, therefore, that there is no disclosure that the document data is sent to multiple locations. Similarly, there is no disclosure envelope data is sent to multiple locations. As such, Appellee has not shown that the abstracted portion (either one of document data or envelope data) is sent to multiple locations.

2. Claims 21 and 22

The rejection of claims 21 and 22 is based on hindsight reconstruction and as such Appellee has not provided in the Examiner's Answer, an explanation why Appellee concludes Harman teaches the limitations of claims 21 and 22. Claims 21 and 22 recite a method. The limitations at issue are steps in the method. Instead of identifying a teaching of the steps in Harman, Appellee merely seeks to identify, in Harman, a structure required by the step. For example, in claim 21 Appellee asserts that because there are separators between

the documents in Harman, then Harman teaches examining the data stream for data patterns including the beginning and ending of each document. Appellee has not pointed to any portion of Harman that teaches this explicitly or inherently. Instead, Appellee, with the aid of claim 21, has reconstructed Harman in an effort to render claim 21 obvious. Appellee similarly rejects claim 22 by relying on a mere disclosure that the job header includes the number of documents as teaching examining the data stream for data patterns including the number of pages of a document. Appellee, therefore, has not shown that Harman teaches all the limitations of claims 21 and 26.

3. Claims 25 and 26

Claim 25 requires, "the step of copying from said data stream portions of said data stream." Apellee does not refute Appellant's assertion in the Appeal Brief that the data stream Appellee is pointing to in Harman is not the data stream copied in claim 25. Instead, Appellee asserts that "Since the parsed attribute data is part of the original data stream [then Harman teaches] copying from said data stream portion of said data stream." In other words, Appellee asserts that copying from a portion of the whole (that is separated from the whole) is copying from the whole. Appellant submits that the claim language "copying from" must be given weight. In claim 25, the copy is made from the data stream. In Harman, as Appellee asserts, the copy is from a second data stream that was previously obtained from the data stream. Claim 26 is similarly distinct from Harman as claim 26 requires copying portions of the data stream including address information with respect to a particular document to be printed. Harman, therefore does not teach all the limitations of claims 25 and 26.

4. Claim 27

Claim 27 requires creating, from the copied address information, a postage indicia. In response to Appellant's assertion that Harman's postage indicia do not include address information, Appellee asserts that Harman creates postage indicia from the address information by using the address information to calculate postage. Additionally, Appellee asserts that claim 27 does not claim creating a postage indicia with the address information. Appellant submits that if the postage indicia is created from the address information then the postage indicia includes address information. Including address information in a postage

indicia is different from using address information to calculate the value of the postage indicia. Thus, Appellee has not shown Harman teaches creating, from the copied address information, a postage indicia as required by claim 27.

5. Claim 40

Claim 40 recites, "examines said data stream for data patterns native to output of said application." In the Exmainer's Answer and Offices Actions, Appellee has not shown how Harman teaches examining for data patterns native to the output of the application in light of Harman disclosing that the original data are modified after the data leaves the application. Instead, Appellee asserts a combination of Microsoft Word and driver 37 as disclosed in Harman.

As discussed with regard to claim 1, the asserted combination of Microsoft Word and driver 37, however, would be in contradiction to the limitation of claim 40 (recited in claim 33) that requires "wherein said data stream is provided by an application which has not been adapted to control said additional printing operations . . . ." In sum, Appellee has not shown that Harman teaches all the limitations of claim 40.

6. Claim 45

Claim 45 requires that a computer product includes a control program for examining the data stream for preestablished data patterns that include the beginning and ending of each document to be printed. Examiner's Answer, page 34. Appellee asserts that because Harman disclose separators between document pages then it is clear Harman teaches a computer product that includes a control program for examining the data stream for preestablished patterns that include the beginning and ending of each document to be printed. Appellant submits that merely showing Harman discloses these separators does not teach the limitation in question. Harman is silent on how a data stream is examined. Harman, therefore, does not teach all the limitations of claim 45.

G. Summary

In sum, Appellee has not shown that dependent claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are obvious in view of Harman. Accordingly,

Appellant respectfully requests that the Board reverse the rejections, under 35 U.S.C. § 103, of claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47.

IV. CONCLUSION

Appellant respectfully requests that the Board overturn the rejections of pending claims 1-4, 6-14, 16-19, 21-27, 30-34, and 37-51 for the above reasons.

Dated: August 26, 2008

Respectfully submitted,

By _____

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